



COPY OF PAPERS
ORIGINALLY FILED

24
5/16/02
Dm
AF
3600

PATENT

I HEREBY CERTIFY THAT THIS CORRESPONDENCE
IS BEING DEPOSITED WITH THE U.S. POSTAL
SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE
ADDRESSED TO: ASSISTANT COMMISSIONER FOR
PATENTS, WASHINGTON, D.C. 20231, ON

RECEIVED

MAY 14 2002

GROUP 3600

April 24, 2002

Amalia J. Melo 4-24-02
SIGNATURE DATE

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appellant : Hiroshi Nemoto
Serial No. : 09/196,029
Reissue Application of
U.S. Patent No. 5,577,767,
Issue Date: November 26,
1996
Filing Date : November 19, 1998
Appeal No. : 2001-2679
For : HOUSING ASSEMBLY FOR AN AIR
BAG AND VEHICLE HORN SWITCH
Group Art Unit : 3618
Examiner : P. Dickson
Attorney Docket No. : TRW(VSSIM)2499RE
Assistant Commissioner for Patents
Washington, D.C. 20231

SUPPLEMENTAL REPLY BRIEF

Sir:

In response to the Order mailed February 28, 2002,
Appellant hereby submits this Supplemental Reply Brief.
Appellant has been required to address the impact of *Pannu v.*
Storz Instruments, Inc., 258 F.3d 1366, 59 USPQ2d 1597
(Fed. Cir. 2001), decided on July 25, 2001, on the issues
before the Board in this appeal.

The facts of *Pannu* distinguish it from the subject case
before the Board in this Appeal. In *Pannu*, in the original

prosecution, the claim at issue was rewritten with one limitation narrowed in order to overcome a prior art rejection. 59 USPQ2d at 1599. On reissue, the same narrowing language was deleted, thereby broadening the claim. *Id.* The Federal Circuit held that this broadening was a recapture of surrendered subject matter. *Id.* at 1601.

In the subject case before the Board, no substantive amendment to claim 6 was made during prosecution in the original application. After a generally boilerplate argument was made following the first and second Office Actions, claim 6 was allowed and issued. In the reissue application, claims 16-18 correspond to issued claims 6-8 and have been made broader by removing the "inner cover" limitation. Reissue Declaration, page 3. The facts and analysis of *Pannu* do not apply to the subject case before the Board in this Appeal. No surrender of subject matter, through amendment, has occurred in the original prosecution in this case.

The *Pannu* analysis focuses on a limitation that was narrowed in order to overcome a prior art rejection in the original prosecution. No limitation of claim 6 in the original prosecution in this case has been narrowed. The *Pannu* analysis is thus inapplicable to this case and has no impact on the issues before the Board in this appeal.

Additionally, the Order of February 28, 2002, itself, states that "on reissue, the patentee is estopped from attempting to recapture the precise limitation the patentee added to overcome prior art rejections". Order, page 2. Since no limitation was added to claim 6 to overcome prior art

rejections, there is no estoppel and *Pannu* does not apply to the subject case before the Board in this Appeal.

The reissue statute, 35 USC §251, provides a patentee with the right to file a broadening reissue application. The recapture doctrine restricts this right. Now, if the Board were to affirm the Examiner's rejection of claims 16-18 in the subject case, Applicant's would be restricted from removing a limitation that was: (i.) in the claims as originally filed; (ii.) and only cursorily mentioned in a recitation of all the limitations of the claim in the "Remarks" section of an Amendment.

Apparently, if the Board were to affirm the rejection in the subject case, only claims that are allowed, as filed, without any discussion at all, will be considered as being broadenable under §251, and not subject to the recapture doctrine. As stated in the Appeal Brief, this interpretation of the statute greatly restricts the possibility of any broadening reissue application. This is in direct conflict with 35 USC §251 (4th paragraph), which permits the patentee to enlarge the scope of a patent within two years from the grant of the original patent.

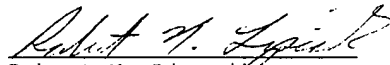
Claims 16-18, while broader than the claims of the parent application as permitted by 35 USC §251, do not recapture subject matter surrendered in the prosecution of the original application.

The rejection of claims 16-18 should be reversed.

Serial No. 09/196,029

Please charge any fees for this Reply Brief to our
Deposit Account No. 20-0090.

Respectfully submitted,



Robert N. Lipcsik

Reg. No. 44,460

TAROLLI, SUNDHEIM, COVELL,
TUMMINO & SZABO
1111 Leader Building
526 Superior Avenue
Cleveland, Ohio 44114-1400
Phone: (216) 621-2234
Fax: (216) 621-4072